UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/007,158	12/05/2001	Jane Brandman	A0000483-01-CA	4222

7590 06/04/2003

Charles W. Ashbrook
Warner-Lambert Company
2800 Plymouth Road
Ann Arbor, MI 48105

EXAMINER
HUI, SAN MING R

ART UNIT	PAPER NUMBER
1617	9

DATE MAILED: 06/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/007,158	Applicant(s) BRANDMAN ET AL.	
	Examiner San-ming Hui	Art Unit 1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 February 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *9 and 10* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *9 and 10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Applicant's amendments filed February 21, 2003 have been entered.

The cancellation of claims 1-8 and 11-12 in amendments filed February 21, 2003 is acknowledged.

The outstanding rejections of claims 6-12 under 35 USC 112, second paragraph are withdrawn in view of the amendments filed February 21, 2003.

The outstanding rejections of claims 6-8 under 35 USC 102(b) are withdrawn in view of the amendments filed February 21, 2003.

Claims 9 and 10 are pending.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Redmond 2 and Thorneycroft et al. in view of Schoonen and Boissonneault, references of record in the previous office action mailed October 1, 2002.

Redmond 2 teaches an oral contraceptive, triphasic combination of norgestimate and ethinyl estradiol (TriCyclen® with gradually increased norgestimate dosage of 0.18, 0.215, 0.25 μg and fixed ethinyl estradiol daosage of 35μg), is effective in treating acne vulgaris (See particularly the abstract). Redmond 2 also teaches the rationale of selecting TriCylcen in the treatment of acne because ethinyl estradiol is known to increase serum levels of sex hormone binding globulin and thereby lower the testosterone level (See page 30S, col. 2, fourth paragraph). Moreover, Redmond 2 teaches that the progestins, norgestimate, has low androgenicity and does not counteract the estrogen-mediated rise in sex hormone binding globulin which results in the decrease of testosterone levels (See page 30S, col. 2, fourth paragraph).

Thorneycroft et al. teaches two oral contraceptives, Alesse® (containing 100μg of levonorgestrel and 20μg of ethinyl estradiol) and Loestrin® Fe 1/20 (containing 1mg of norethindrone acetate and 20μg of ethinyl estradiol), are effective in reducing acne (See particularly the abstract, also page 257, col. 2 – page 259, col. 2; also Figure 2 and Tables 3 and 4). Thorneycroft et al. also teaches that both levonorgestrel and norethindrone acetate can reduce the androgen levels (See the abstract). Thorneycroft et al. also teaches that both Alesse® and Loestrin® Fe 1/20 are significantly reduce the totals testosteron and increase the SHBG level (See page 258, Figure 1).

The references do not expressly teach the specific herein claimed dosage regimen of Estrostep or an effective amount of 1mg norethindrone acetate and a gradually increasing dose of ethinyl estradiol: 20μg for 5days, 30μg for 7 days and 35μg for 9 days.

Schoonen teaches norethindrone (also known as Norethisterone) has a very weak androgenicity and estrogenicity (See particularly the abstract).

Boissonneault teaches the specific herein claimed regimen of norethindrone acetate and ethinyl estradiol is useful as oral contraceptive (See col. 3, Table 1).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the herein claimed regimen of administering norethindroe and ethinyl estradiol to treat acne vulgaris.

One of ordinary skill in the art would have been motivated to employ the herein claimed regimen of administering norethindrone acetate and ethinyl estradiol to treat acne vulgaris. Firstly, based on the cited prior art, it is known that different oral contraceptives containing different progestins and ethinyl estradiol, such as TriCylen®, Alesse®, and Loestrin® Fe 1/20, are useful in treating acne vulgaris. Therefore, using yet another known oral contraceptives, such as Estrostep (taught by Boissonneault), in the treatment of acne vulgaris would be reasonably expect to be effective. Secondly, norethindrone acetate is known to have weak androgenicity and known to reduce the testosterone levels. Therefore, based on Redmond 2, substituting a progestin that has low androgenicity and would reduce testosterone level, such as norethindrone acetate, for norgestimate in the oral contraceptives would be reasonably expected to be effective

in treating acne. Thirdly, the optimization of result effect parameters (e.g., dosing regimens) is obvious as being within the skill of the artisan, absent evidence to the contrary.

Response to Arguments

Applicant's arguments filed February 21, 2003 averring the presence of unexpected results have been fully considered but they are not persuasive. Examiner notes that it is applicant's burden to demonstrate unexpected results over the prior art. See MPEP 716.02, also 716.02 (a) - (g). Furthermore, the unexpected results should be demonstrated with evidence that the differences in results are in fact unexpected and unobvious and of both statistical and practical significance. *Ex parte Gelles*, 22 USPQ2d 1318, 1319 (Bd. Pat. App. & Inter. 1992). Moreover, evidence as to any unexpected benefits must be "clear and convincing" *In re Lohr*, 137 USPQ 548 (CCPA 1963), and be of a scope reasonably commensurate with the scope of the subject matter claimed, *In re Linder*, 173 USPQ 356 (CCPA 1972). In the instant case, example 2 in the instant specification page 28 - 41 is considered. The example is merely showing the efficacy of the herein claimed regimen in the treatment of acne, which is an expected result in view of the teachings of the cited prior art. Therefore, no unexpected benefits were seen to be present herein.

Applicant's arguments filed February 21, 2003 averring Redmond employing a fixed dose and the herein invention employing a lower dose of etrogen have been considered, but are not found persuasive. The cited prior art actually teaches low-dose

estrogen oral contraceptives are also effective in treating acne (See Thorneycroft et al.'s teachings about Alesse® and Loestin® Fe 1/20, which containing 20mcg of ethinyl estradiol). Therefore, possessing the teachings of the cited prior art, one of ordinary skill in the art would have been motivated to employ the herein claimed estrogen dosage for the treatment of acne, absent evidence to the contrary.

Applicant's arguments filed February 21, 2003 averring the cited prior art's failure to teach patients with severe acne can be treated with the herein recited regimen have been considered, but are not found persuasive. Examiner notes that claim 9 encompasses every patients suffered from acne, which does not distinguish the severity of acne in the patients herein. Therefore, possessing the teachings of the cited prior art, one of ordinary skill in the art would have been motivated to employ any oral contraceptives, such as Estrostep, in the treatment of acne would be reasonably expected to be effective, absent evidence to the contrary.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to San-ming Hui whose telephone number is (703) 305-1002. The examiner can normally be reached on Mon 9:00 to 1:00, Tu - Fri from 9:00 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, PhD., can be reached on (703) 305-1877. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

San-ming Hui
June 2, 2003

SREENI PADMANABHAN
PRIMARY EXAMINER

6/2/03